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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,124	11/17/2006	Tomohiko Ohta	L7350.0010	1070

32172 7590 12/05/2008  
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NEW YORK, NY 10036-2714

EXAMINER
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GUSSOW, ANNE

ART UNIT	PAPER NUMBER
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1643

MAIL DATE	DELIVERY MODE
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12/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,124	<b>Applicant(s)</b> OHTA, TOMOHIKO	
	<b>Examiner</b> ANNE M. GUSSOW	<b>Art Unit</b> 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/2/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claim 10 has been amended.  
Claims 1-9 have been canceled.
2. Claim 10 is under examination.

### ***Priority***

3. As discussed in applicant's telephonic interview on March 27, 2008, the instant national state entry is believed to be identical to the corresponding PCT application (PCT/JP05/01870) and the instant claims receive the priority date of February 2, 2004 for art rejection purposes.

### ***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on September 2, 2008 was filed after the mailing date of the first action on the merits on March 17, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner and an initialed copy of the IDS is included with the mailing of this office action.

### ***Drawings***

5. The drawings were received on March 17, 2008. These drawings are accepted.

***Objections Withdrawn***

6. The objections to the drawings are withdrawn in view of applicant's filing of replacement color drawings on March 17, 2008.

7. The objections to the specification are withdrawn in view of applicant's amendment to the specification.

***Rejections Withdrawn***

8. The rejection of claim 10 under 35 U.S.C. 102(b) as being anticipated by Rao, et al. (US PAT 6,720,158) is withdrawn in view of applicant's arguments.

9. The rejection of claim 10 under 35 U.S.C. 102(b) as being anticipated by Hayami, et al. is withdrawn in view of the earlier priority date of the instant claims (see 4 above).

***Rejections Maintained***

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The rejection of claim 10 under 35 U.S.C. 102(b) as being anticipated by Wang, et al. (Oncogene, 1997. Vol. 15, pages 143-157) is maintained.

The response filed September 2, 2008 has been carefully considered but is deemed not to be persuasive. The response states that applicant notes that Wang et al. does not expressly or inherently describe each and every element of claim 10, as amended. For example, amended Claim 10 recites "transporting BRCA1 from a nucleus to cytoplasm" and "wherein the co-expression of BRCA1 and CDK2-cyclin E and/or CDK2-cyclin A transports BRCA1 from the nucleus to cytoplasm." Nowhere does Wang et al, describe either of these elements (see response page 12).

In response to this argument, Wang, et al. teach association of BRCA1 with cyclin A (see abstract and figures 4 and 5). The claim requires co-expression of BRCA1 and cyclin A. Since Wang, et al. teach BRCA1 and cyclin A are associated with each other, they are co-expressed. The movement of BRCA1 from the nucleus to the cytoplasm is an effect of the co-expression; therefore the complex of Wang, et al. would necessarily be transported from the nucleus to the cytoplasm. *Atlas Powder Co. V. IRECO, Inc* 51 USPQ2d 1943 (Fed. Cir. 1999). Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art... However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. The Court further held that this same reasoning holds true when it is not a property but an ingredient which is inherently contained in the prior art.

Therefore after a fresh consideration of the claim and the evidence provided the rejection is maintained.

***Conclusion***

12. No claims are allowed.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNE M. GUSSOW whose telephone number is (571)272-6047. The examiner can normally be reached on Monday - Friday 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anne M. Gussow

December 1, 2008

/David J Blanchard/  
Primary Examiner, Art Unit 1643